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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,421	02/28/2002	Hiroshi Matsuda	03500.016241	7453
5514	7590	05/16/2007	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			RUDOLPH, VINCENT M	
		ART UNIT	PAPER NUMBER	
		2625		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/084,421	MATSUDA, HIROSHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vincent M. Rudolph	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- ' Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 February 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 55-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 55-82 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 February 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/22/2007 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 55-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan ('070) in view of Morgan ('674).

Regarding claim 55, Chan ('070) discloses an image processing device (secure printer, See Figure 1, Element 140), that can be connected to an information processing device (local computer, See Figure 1, Element 100). This device has a first authentication processing means (the device performs the action, thus it becomes the means), which is done in response to a request from the information processing device (secure printing process that includes the identity of the intended recipient, See Col. 6, Line 2-7), for an authenticating process according to the request made from the

information processing device (user enters the required information in order to be authenticated, Col. 6, Line 8-12), a first discrimination means for deciding whether an operation unit of the image processing device is setting a first function (user is provided with the status information of the document at the printer, See Col. 7, Line 14-18), a display information transmission means (graphical user interface, See Col. 6, Line 4-5) for transmitting the screen contents for operating the information processing device by supplying information (document details) about the image processing device when a request from the information processing device is recognized based on the authentication result by the authentication processing means and the discrimination result (once information to identify the user is recognized, the directory server returns to the computer the public key for the sender, See Col. 6, Line 12-14). The device has a second authentication processing means that reads information stored on a card (smart card, See Figure 1, Element 145), which is inserted into the image processing device (See Col. 6, Line 58-61).

Chan ('070) does not disclose having the information processing device set a second function of the image processing device as well as transmitting information from the image processing device to the information processing device.

Morgan ('674) discloses having the printing client (See Figure 1, Element 18a and 18b) set a function of the image processing device (printing client sets to see if the printing request has been accepted or how many pages were printed so far, See Col. 7, Line 34-42) as well as transmit information from the image processing device (print

server and printers, See Figure 1) to the printing client (responds to status queries, See Col. 7, Line 30-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include having the information processing device inquire about a print job, such as the one disclosed within Morgan ('674), and incorporate it into the image processing device of Chan ('070) because it allows a user to receive information to know whether the requested printer has accepted the print job prior to being processed rather than waiting to see if the printed has accepted it by outputting the document.

Thus, by incorporating Morgan ('674) into Chan ('070), a request from an operation unit within the image processing device is recognized based on the second authentication and the second discrimination result, and thus the image processing device is operable by the operation unit (See Col. 7, Line 1-20), such that the first function and second function are different than the authentication processes performed by the first and second authentication processes (first and second function relate to the status of the print job, whereas the first and second authentication processes identify the user prior to submitting/outputting the print job).

Regarding claim 56, Chan ('070) discloses an image processing device (secure printer, See Figure 1, Element 140), that can be connected to an information processing device (a local computer, See Figure 1, Element 100). This device has a first authentication input means (the device performs the action, thus is becomes the means), which is done in response to a request from the information processing device

(secure printing process that includes the identity of the intended recipient, See Col. 6, Line 2-7), for inputting the requested authentication information from the information processing device (user inputs the required information in order to be authenticated, Col. 6, Line 8-12), a second authentication input means is performed for inputting authentication information input from an operation unit (smart card, See Figure 1, Element 145), which is inserted into the image processing device (See Col. 6, Line 58-61). This device has an authentication processing means (smart card reader of the secure printer, See Col. 6, Line 58-61) for performing an authenticating process according to the information input from either authentication input means as well as the authentication information in the image processing device (the user inputs the smart card at the image processing device in order to have the identity verified prior to printing, See Col. 6, Line 58-Col. 7, Line 6), a discrimination means for deciding whether the operation unit of the image processing device is setting a first function on the image processing device (user is provided with the status information of the document at the printer, See Col. 7, Line 14-18), a display information transmission means (graphical user interface, See Col. 6, Line 4-5) for transmitting the screen contents for operating the information processing device by supplying information (document details) about the image processing device when a request from the information processing device is recognized based on the authentication result by the authentication processing means and the discrimination result (once information to identify the user is recognized, the directory server returns to the computer the public key for the sender, See Col. 6, Line 12-14). Whenever the authentication information inputted by the second input means is

authenticated by the authentication processing means and the image processing device determines that a second function of the image processing device is being set in the image processing device (select which document to retrieve, which is done at the printer, See Col. 7, Line 16-20), the operation in the operation unit is accepted based on the authentication result (user is verified and is able to output the selected document, See Col. 7, Line 1-20), such that the first function and second function are different than the authentication processes performed by the authentication processes (first and second function relate to the status of the print job, whereas the authentication processes identify the user prior to submitting/outputting the print job).

Chan ('070) does not disclose transmitting the information from the image processing device to the information processing device.

Morgan ('674) discloses transmitting the information from the image processing device (print server and printers, See Figure 1) to the printing client (responds to status queries, See Col. 7, Line 30-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include having the information processing device inquire about a print job, such as the one disclosed within Morgan ('674), and incorporate it into the image processing device of Chan ('070) because it allows a user to receive information to know whether the requested printer has accepted the print job prior to being processed rather than waiting to see if the printed has accepted it by outputting the document.

Regarding claim 57, Chan ('070) discloses an image processing device, (secure printer, See Figure 1, Element 140), that can be connected to an information processing device (local computer, See Figure 1, Element 100). This device has a first authentication processing means (the device performs the action, thus it becomes the means), which is done in response to a request from the information processing device (secure printing process that includes the identity of the intended recipient, See Col. 6, Line 2-7), for an authenticating process according to the request made from the information processing device (user enters the required information in order to be authenticated, Col. 6, Line 8-12), a display information transmission means (graphical user interface, See Col. 6, Line 4-5) for transmitting the screen contents for operating the information processing device by supplying information (document details) about the image processing device when a request is authenticated and recognized (See Col. 6, Line 2-14), a second authentication processing means for performing authenticating process according to information stored on a card (smart card, See Figure 1, Element 145), which is inputted into the card reader (See Col. 6, Line 58-61). Whenever a request from the operation unit to set a function of the image processing device (check status information of the document at the printer, See Col. 7, Line 14-18) is accepted based on the authentication result by the second authentication processing means (user is verified and is able to output the selected document, See Col. 7, Line 1-20).

Chan ('070) does not disclose a request to set the image processing device from the information processing device relating to a function as well as transmitting information from the image processing device to the information processing device.

Morgan ('674) discloses having the printing client (See Figure 1, Element 18a and 18b) set a function of the image processing device (printing client sets to see if the printing request has been accepted or how many pages were printed so far, See Col. 7, Line 34-42) as well as transmit information from the image processing device (print server and printers, See Figure 1) to the printing client (responds to status queries, See Col. 7, Line 30-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include having the information processing device inquire about a print job, such as the one disclosed within Morgan ('674), and incorporate it into the image processing device of Chan ('070) because it allows a user to receive information to know whether the requested printer has accepted the print job prior to being processed rather than waiting to see if the printed has accepted it by outputting the document.

Thus, by incorporating Morgan ('674) into Chan ('070), the request to operate the image processing device from the information processing device is not accepted (since the user checked the status of the print job at the printer, See Col. 7, Line 14-18), such that the function of the image processing device requested to be set by the operation unit is different than the authenticating processes performed by the first and second authentication processes as well as the request to operate the image processing device from the information processing device relates to a function different than the authentication processes performed by the first and second authentication processes (the function of the image processing device to be operated by the operation unit of the

image processing device as well as from the information processing device both relate to the status of the print job, whereas the first and second authentication processes identify the user prior to submitting/outputting the print job).

Regarding claim 58, Chan ('070) discloses an image processing device (secure printer, See Figure 1, Element 140), that can be connected to an information processing device (local computer, See Figure 1, Element 100). This device has a first authentication processing means (the device performs the action, thus it becomes the means), which is done in response to a request from the information processing device (secure printing process that includes the identity of the intended recipient, See Col. 6, Line 2-7), for an authenticating process according to the request made from the information processing device (user enters the required information in order to be authenticated, Col. 6, Line 8-12), a display information transmission means (graphical user interface, See Col. 6, Line 4-5) for transmitting the screen contents for operating the information processing device by supplying information (document details) about the image processing device when a request is authenticated and recognized (See Col. 6, Line 2-14), a second authentication processing means for performing authenticating process according to information stored on a card (smart card, See Figure 1, Element 145), which is inputted into the card reader (See Col. 6, Line 58-61).

Chan ('070) does not disclose a request to set a function of the image processing device from the information processing device as well as transmitting information from the image processing device to the information processing device.

Morgan ('674) discloses having the printing client (See Figure 1, Element 18a and 18b) submit a request to set a function of the image processing device (printing client sets to see if the printing request has been accepted or how many pages were printed so far, See Col. 7, Line 34-42) as well as transmit information from the image processing device (print server and printers, See Figure 1) to the printing client (responds to status queries, See Col. 7, Line 30-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include having the information processing device inquire about a print job, such as the one disclosed within Morgan ('674), and incorporate it into the image processing device of Chan ('070) because it allows a user to receive information to know whether the requested printer has accepted the print job prior to being processed rather than waiting to see if the printed has accepted it by outputting the document.

Thus, by incorporating Morgan ('674) into Chan ('070), whenever a request to operate on setting information for a function of the image processing device from the information processing device is accepted based on the authentication result by the first authentication processing means, a request to operate the image processing device from the operation unit is not accepted (since the user already used the printing client to check the status of the print job), such that the function of the image processing device requested to be set from the information processing device and the operation of the image processing device requested to be performed from the operation unit are different than the authenticating processes performed by the first and second authentication

processes (the function of the image processing device to be operated from the information processing device as well as by the operation unit of the image processing device both relate to the status of the print job, whereas the first and second authentication processes identify the user prior to submitting/outputting the print job).

Regarding claim 59, Chan ('070) discloses the first authentication and second authentication processing means perform an authenticating process on the same authentication information (the recipient's identity) as set within the image processing device (to verify this is the same user that wishes to print out the requested document, See Col. 6, Line 58-Col. 7, Line 6).

Regarding claim 60, Chan ('070) discloses an identification information means (the device becomes the means) for issuing identification information (the public key for the intended recipient, Col. 6, Line 12-13) to the information processing device (the local computer, Figure 1, Element 100) when a request from the information processing device is recognized (the user submits a document to be printed, Col. 5, Line 66-Col. 6, Line 2) based on the authentication result (smart card is correctly identified to the intended user, Col. 7, Line 1-7) by the authentication processing means (smart card reader of the secure printer; See Col. 6, Line 58-61). There is also a determination means (device becomes the means) for determining, in response to a request from the information processing device, that the identification information transmitted is added to the request (See Col. 6, Line 4-14). Whenever the determination means determines the identification information is added, the display information transmits the display

information with an authenticating process since the requested information is already sent and this information is to verify the intended recipient (See Col. 6, Line 2-14).

Regarding claim 61, Chan ('070) discloses the display information can be accessed via the Internet so a user could modify the profile if one wishes to receive documents from one specified printer (See Col. 8, Line 17-29) and the request from the information processing device and the display information are transmitted and received through a network so the information is transmitted to the printer through a protocol (See Col. 7, Line 55-62).

Chan ('070) does not disclose the display information is described in an HTML document as well as transmitted and received according to an HTTP protocol.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have the information, when accessed by the Internet, in an HTML document since the majority of information provided over the Internet is viewed as an HTML document and most computers include a browser capable of displaying a HTML document. Also, since information is sent across a network, an HTTP protocol is needed, such as an IP address, to properly transmit and receive the requested information.

Regarding claim 62, Chan ('070) discloses a conversion means (device becomes the means) for converting the request for authentication input by the first and second authentication input means into a format interpretable by the authentication processing means (a public key is used regarding the intended recipient for the first authentication

input, See Col. 6, Line 12-13, and the private key is used as the second authentication for the user in order to retrieve the document, See Col. 6, Line 38-40).

Regarding claims 63-82, the rationale provided in the rejection of claims 55-61 is incorporated herein. In addition, the device of claims 55-61 corresponds to the method of claims 63-70, the computer-readable storage medium (See Figure 2) of claims 71-74 as well as the device of claims 75-82 and performs the steps disclosed herein.

***Response to Arguments***

The applicant argues that the prior art does not disclose steps to control an image processing device at the device itself as well as from an information processing device that accesses the device. Chan discloses that a user is able to operate a function at the printing device, which is a user is able to check status information of the print job (See Col. 7, Line 14-18). Even though Chan does not disclose setting a function at the information processing device, by incorporating the prior art of Morgan, it is able to meet the limitations of the amended claims. Morgan discloses having the information processing device set a function of the image processing device, such as setting to see if the printing request has been accepted or how many pages were printed so far (See Col. 7, Line 34-42). By incorporating this teaching into Chan, it provides the user the ability to receive information to know whether the requested printer has accepted the print job prior to being processed rather than waiting to see if the printer has accepted it by outputting the document. Also, these functions are distinct from the authentication processes, which are used to validate a user prior to

outputting the document (Col. 6, Line 58-Col. 7, Line 6). As a result, the combined prior art is able to meet the limitations of the amended claims.

The examiner suggests distinctly pointing out preventing conflicting settings from being inputted by a user inputting them into a control panel at the image processing device and from a remote user that accesses the device over a network using an information processing device as well as pointing out what the first and second functions are referring, such as the examples that were used in the specifications on page 20, 34, 37 and 41, as described in the remarks on page 35.

By incorporating those limitations into the claims, it would be able to overcome the prior art of record, but may require further searching and consideration.

Based on these facts, **THIS ACTION IS MADE NON-FINAL.**

***Conclusion***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is: Hisatomi ('766).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent M. Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

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5/10/07

VMR

Vincent M. Rudolph

Examiner

Art Unit 2625

AUNG S. MOE  
SUPERVISORY PATENT EXAMINER  
5/11/07